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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/461,974 | 12/15/1999 | DONALD L. HOFFMAN | 082225.P2392 | 4506 |

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EXAMINER

HYUN, SOON D

ART UNIT

PAPER NUMBER

2663

DATE MAILED: 03/19/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,974

Applicant(s)

HOFFMAN, DONALD L.

Examiner

Soon-Dong Hyun

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 8-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20, 22-24 and 26 is/are rejected.
- 7) ☒ Claim(s) 2-4, 8-17, 21, 25 and 27-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 2, 8-10, and 18-22 are objected to because of the following informalities.

Claims 2, 8-10, and 18-22 are objected to because all instances of "configured to" in each claim should have been deleted to make the claim positive. Language such as "adapted to/for", "configured to/for", or arranged to/for" (or similar phrases such as "enabled to", "capable of", etc.) Is not considered positive recitation per MPEP 2106.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2663

4. Claims 18-20, 22-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Punj et al (U.S. Patent No. 5,150,358) in view of Turner (U.S. Patent No. 5,402,415).

Punj discloses an ATM switch handling multiple priorities for an ATM cell being output from a network element (a switch) on at least two output ports (120 in FIG. 1), each of the output port comprising:

a plurality of output queues (Q1-Q3) at each output port, each output queue having a unique priority (priority level 1 to 3, respectively);

a memory (a routing table) to output priority information associated with the cell indicating to which output port queue at each output port the cell will be directed. The routing table is not clearly shown, but the table is inherently required for switching. During a call setup process, a virtual circuit information and a peak rate information are provided with a call setup request and thus, a priority information corresponding to the peak rate and the virtual circuit information are stored in a memory for switching, see FIG. 2 and 3;

a central processing unit coupled to the memory (122); and a computer program mechanism coupled to the central processing unit and to override the priority information if the flow associated with the cell sends the cells in excess of one or more negotiated parameters, i.e., the priority level is increased (for example, from level 2 to level 1) if the cell in a queue corresponding to the priority level 2 has been enqueued in excess of a predetermined cell time, see col. 3, line 60-col. 4, line 20.

However, Punj do not teach a switching method for multicasting. Turner discloses an ATM switch for multicasting (FIG. 3C). Those of skill in the art would have been motivated by Turner to multicast an incoming ATM cell of Punj to a plurality of output ports.

Art Unit: 2663

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate a multicasting switching method of Turner in the switch of Punj to multicast an ATM cell to a plurality of destinations.

Allowable Subject Matter

5. Claims 2-4, 8-17, 27 and 28 would be allowable if the claim objections are corrected.
6. Claims 21, 25, 29, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Soon-Dong Hyun whose telephone number is (703) 305-4550. The examiner can normally be reached on Monday-Friday from 8:30 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen, can be reached on (703) 308-5340.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

8. Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Application/Control Number: 09/461,974

Page 5

Art Unit: 2663

Or faxed to: 703-872-9306 for formal communications intended for entry with a label of "OFFICIAL" and for informal or draft communications with a label of "PROPOSED" or "DRAFT" (attn: Art Unit 2663, Soon-Dong Hyun).


S. Hyun

03/15/2004


ANDY LEE
PATENT EXAMINER